

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ASHOK K. SHUKLA,
MUKTA M. SHUKLA and AMITA M. SHUKLA

Appeal No. 2005-2478
Application No. 09/591,009

HEARD: November 15, 2005

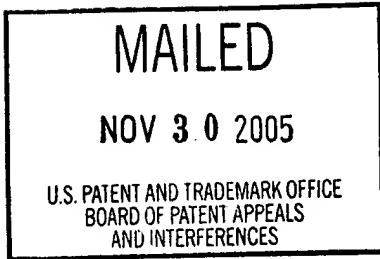
Before OWENS, KRATZ and FRANKLIN, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4, 5, 7-11, 13-16 and 20, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a pipette tip having an open upper end and a closed lower end and containing chromatographic particles. The closed lower end includes one or more perforations to permit the passage of fluids while retaining chromatographic particles in the pipette tip. Claim 1 is reproduced below.



1. A pipette tip for sample preparation, which contains chromatography particles and has an open upper end and a closed lower end and has one or more perforations at the said lower end to permit the passage of fluids through said perforations while retaining chromatographic particles in the said pipette tip.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Golias	4,341,635	Jul. 27, 1982
Sanford et al. (Sanford)	5,589,063	Dec. 31, 1996
Valaskovic ¹	6,190,559	Feb. 20, 2001
		(filed Aug. 02, 1999)

Claims 1, 2, 4, 5, 7-11, 13-16 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Valaskovic. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Valaskovic in view of Sanford. Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Valaskovic in view of Sanford and Golias.

OPINION

Having carefully considered each of appellants' arguments set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner.

¹ Appellants do not dispute that Valaskovic is available as prior art under 35 U.S.C. § 102(e) based on the effective filing date thereof.

Accordingly, we will affirm the examiner's rejections for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

Appellants maintain that "[c]laim 1 is the only claim being contested since all the other claims are dependent on claim 1" (appeal brief, item No. 7). Consonant with that statement, appellants' arguments furnished in a supplemental brief filed March 21, 2003 are based on the alleged patentability of independent claim 1.² In this regard, applicants' arguments against the examiner's separate § 103(a) rejections of dependent claims 4 and 20, as presented in the supplemental brief, are also based on the features of claim 1, from which they depend. Thus, we shall primarily focus on claim 1 in deciding this appeal.

As set forth by our reviewing court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), for a proper anticipation rejection under 35 U.S.C. § 102, it is only necessary

² A brief in compliance with all of the requirements set forth in 37 CFR 1.192(c)1-(c)(8) is not required, by Regulation, for applicant(s), who are not represented by a registered practitioner. See the exception provided in 37 CFR 1.192(c), as in effect at the time of the filing of the briefs herein, and the updated replacement Regulation, 37 CFR § 41.37(c)(1), (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Here, the examiner (answer, paragraph bridging pages 5 and 6) has determined that Valaskovic discloses a pipette tip that includes an open upper end and a closed lower end with a perforation (opening) therein. The pipette tip retains chromatographic particles placed therein while permitting the passage of fluids through the perforation. See the specific portions of Valaskovic referred to by the examiner and the recitations in appealed claim 1.

Appellants, on the other hand, maintain that the claim 1 device differs from Valaskovic in the method of adding the chromatographic particles to the pipette tube and in sizing the perforation (slit) of the tip such that the size of the chromatographic particles are larger than the perforation (slit width). In this regard, appellants argue that the pipette (tip) opening of Valaskovic is several times the diameter of the particles in the pipette, the method of loading the tube (pipette) of Valaskovic is different than appellants' method, and

sintering is required by Valaskovic. See pages 3 and 4 of the supplement to appeal brief.

We do not agree with appellants because the appealed claims are not limited to a device having a relative perforation size as argued. Structural features that are disclosed in appellants' specification but not claimed do not distinguish the claimed invention from the applied prior art. This is so because the claims are the measure of the invention sought to be protected by appellants, not the specification. Consequently, our review of the merits of the examiner's rejections focuses on the scope of the claimed subject matter versus what is disclosed in the applied prior art.

While appellants' specification discloses a pipette tip with perforation(s) having dimensions relative to the size of chromatography particles held in the tip such that those particles can not pass through the tip (see, e.g., the description of Figures 3 and 4 at page 8 of appellants' specification), all of the appealed claims before us, and in particular argued claim 1, do not recite such a limitation.³ Similarly, the appealed claims, particularly argued claim 1, are

³ The examiner's non-entry of a previously filed proposed amendment after final rejection is a petitionable matter and is not before us for review. See 37 CFR 1.181.

not drawn to a method of filling a pipette tip with chromatographic particles, or a pipette tip including only non-sintered particles, as argued to be patentable distinctions.

For reasons stated in the answer, we agree with the examiner that contested appealed claim 1 reads on the disclosure of Valaskovic. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). It follows that we shall affirm the examiner's § 102(e) anticipation/§ 103(a) obviousness rejection of claims 1, 2, 4, 5, 7-11, 13-16 and 20 over Valaskovic.

Concerning the examiner's separate obviousness rejection of dependent claim 4 over Valaskovic in view of Sanford, appellants do not dispute the examiner's determination that Sanford in combination with Valaskovic would have rendered the use of multiple joined pipette tips in Valaskovic obvious to one of ordinary skill in the art at the time of the invention. Rather, appellants urge that claim 4 is unobvious over the applied references for the same reasons as independent claim 1. However,

for reasons stated above and in the answer, we do not find that argument persuasive. Consequently, we shall affirm the examiner's § 103(a) rejection of claim 4.

Appellants do not contest the examiner's separate obviousness rejection of claim 20 based on the limitations of dependent claim 20 and the examiner's additional application of Golias thereto. Rather, appellants base their arguments against the separate rejection of claim 20 on the features of independent claim 1. Again, it follows that, on this record, we shall also sustain the examiner's rejection of claim 20 for the reasons stated in the answer and above.

CONCLUSION

The decision of the examiner to reject claims 1, 2, 4, 5, 7-11, 13-16 and 20 under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Valaskovic; to reject claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Valaskovic in view of Sanford; and to reject claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Valaskovic in view of Sanford and Golias is affirmed.

AFFIRMED

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